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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,199	04/17/2006	Tatsushi Ako	740709-556	8702
22204	7590	10/01/2008	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			TISCHLER, FRANCES	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			10/01/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,199

Applicant(s)

AKO ET AL.

Examiner

Frances Tischler

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date 7/21/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, claim 13 in the reply filed on 8/11/08 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Casey (US H1120) as evidenced by the Handbook of Thermoplastic Elastomers (pages 13 – 27).**
4. **Casey** discloses (abstract, 4:24 – 42) a method of processing recyclable thermoplastic material where at least one filler is added to the recyclable thermoplastic. The fillers can be present as an intrinsic part of the constituents of the recyclable polymer or can be added prior or during the recycling processing. They can be organic or inorganic, such as calcium carbonate, talc, carbon black, pigments, pulp, paper, cellulose, coffee grounds, thermoplastics, thermosets, etc.

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(5:1 – 23), in amounts of preferably 5 – 15 wt% but can be up to 85 wt% (5:56 – end). Blending of the recyclable thermoplastic with the fillers is done by dry blending the components in a powder or pellet form (5:25 – 37), after which the mixture is melted during extrusion processing or injection molding (7:table II).

5. **The Handbook of Thermoplastic Elastomers** discloses that practically all thermoplastic resins contain essential stabilizers that are added during or immediately after polymerization, the types and amounts of which vary depending on the type of polymer. Other additives may be added for specific characteristics desired (page 13, column 1, paragraph 1). Antioxidants, for example, are added at levels ranging from 0.05 – 1% (page 13, column 1, paragraph 4) of the weight of the polymer. If free radical scavengers are used, they generally range from 0.1—1.5% (page 14, column 1, paragraph 5); antistatic agents range from 0.5 – 1% (page 19, column 2, paragraph 1), etc. These ranges correspond to applicant's range of non-thermoplastic solid foreign material contained in the waste thermoplastic resin.

6. Casey discloses that fillers may be present as an intrinsic part of the constituents of the recyclable polymer but is silent on the specific amounts. However, it is inherently present in the same amounts as claimed by applicant of 0.001 – 2 wt%, as evidenced by *The Handbook of Thermoplastic elastomers* which cites that these same amounts are typically added when the thermoplastics are originally made. Additionally, optical properties, such as the

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one claimed by applicant of $C \times D > 4000$, are also inherently present since a chemical composition and its properties are inseparable. *In re Sparta*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir.1990). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established." See MPEP 2112.01

7. Casey discloses the addition of fillers, such as carbon black, talc, etc., in amounts of 1 – 85%, to the recyclable polymer. Applicant claims that the addition of a filler gives the composition an optical property of $A \times B \leq 4000$. Fillers, such as carbon black, interfere with light transmittance of a polymer. Therefore, the addition of any amount of a filler, such as carbon black, will inherently give Casey's polymer the same optical property as claimed by applicant of equal or higher than 4000 where 4000 is the value before the addition of said filler. A chemical composition and its properties are inseparable. *In re Sparta*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir.1990). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established." See MPEP 2112.01

Examiner Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frances Tischler whose telephone number is (571)270-5458. The examiner can normally be reached on Monday-Friday 7:30AM - 5:00 PM; off every other Friday.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seileck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Frances Tischler
Examiner
Art Unit 1796

/FT/

